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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|--------------------------|------------------|
| 10/634,336 | 08/04/2003 | Kyle R. Gee | | 6767 |
| 23358 | 7590 | 01/05/2006 | | |
| KOREN ANDERSON MOLECULAR PROBES, INC. 29851 WILLOW CREEK ROAD EUGENE, OR 97402-9132 | | | EXAMINER KIFLE, BRUCK | |
| | | | ART UNIT 1624 | PAPER NUMBER |

DATE MAILED: 01/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|---------------------------------------|-----------------------------------|--|
| Office Action Summary | Application No. 10/634,336 | Applicant(s) GEE ET AL. | |
| | Examiner Bruck Kifle, Ph.D. | Art Unit 1624 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 28-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

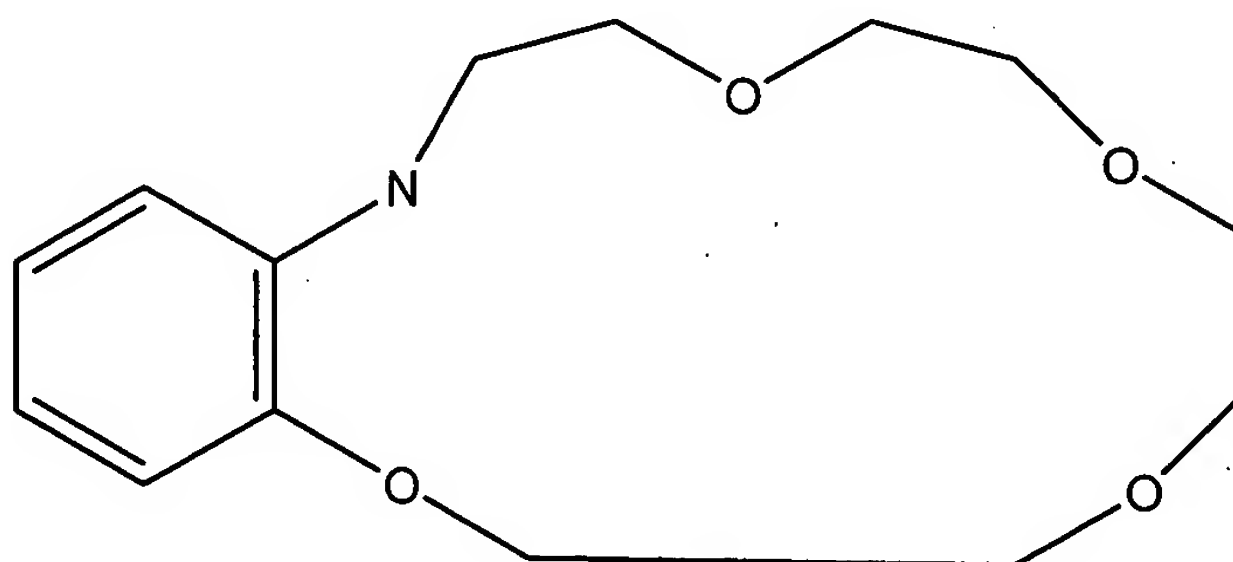
- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>10/05 and 11/05</u> . | 6) <input type="checkbox"/> Other: _____ |

Applicant's remarks filed 10/25/05 have been received and reviewed. Claims 1-38 are still pending in this application.

Claims 28-38 (along with subject matter not falling under the above core) are withdrawn from consideration because they are drawn to compositions, methods and kits that raise different issues of patentability and require separate searches.

Election/Restrictions

Applicant's election of the compound 86 on pages 96-97 in the reply filed on 07/17/05 is acknowledged.

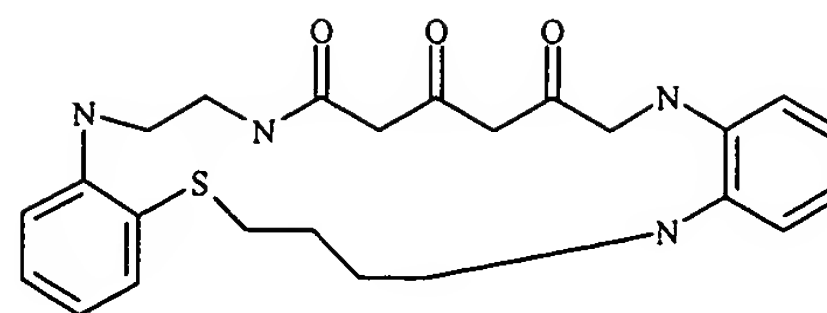
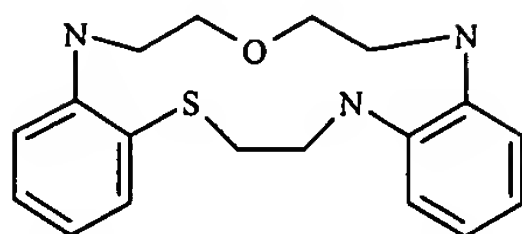
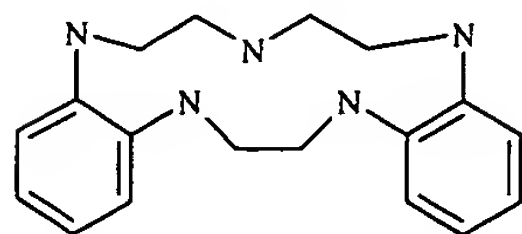


Compounds embraced by this core are under consideration. The search did not extend to compounds wherein Sc is as defined in claims 8 and 9 because these biomolecules require separate searches. Should Applicants maintain these groups, a restriction requirement will be made to elect a specific Sc group.

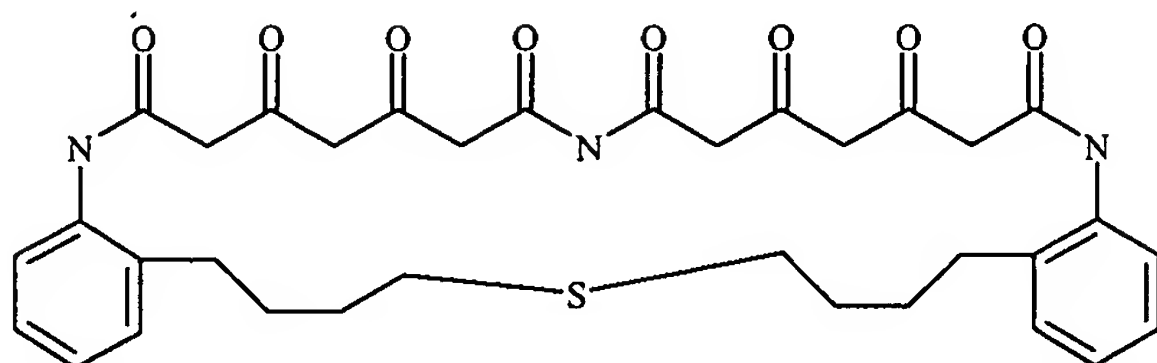
Applicants argue that the compounds embraced by the claims not distinct or independent because the compounds are not made or used independently. This is not found persuasive because compounds embraced by claim 1 are indeed patentably distinct, raise different issues of patentability and are extremely burdensome for the office to search and examine.

Claim 1 embraces cores, such as,

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and



The search of each such core has to be done which is not possible without serious burden. The above four structures signify a tiny subset of what is embraced by claim 1 which does not include further ring fusions. There are thousands of different cores present in the instant claims and these compounds further contain sugars, proteins, nucleic acids, polymers, cells, viruses, etc. which are classified separately and examined by different groups at the USPTO.

Compounds, corresponding compositions, a method of use and a process of making that are of the same scope are considered to form a single inventive concept. The compounds instantly claimed are not so linked as to form a single inventive concept. The compounds are so diverse in scope that a prior art anticipating one compound under 35 USC 102 would not render obvious another compound of the same claim under 35 USC 103. This is evidentiary of patentably distinct and independent inventions.

The requirement is still deemed proper and is therefore made FINAL.

Improper Markush Rejection

Claims 1-27 are rejected under a judicially created doctrine as being drawn to an improper Markush group, that is, the claims lack unity of invention. The variables E¹, E², E³, P

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and Q are defined in such a way that they keep changing the core of the compound that determines the classification and search. By changing these values, several patentably distinct and independent compounds are claimed. In order to have unity of invention the compounds must have "a community of chemical or physical characteristics" which justify their inclusion in a common group, and that such inclusion is not repugnant to principles of scientific classification" In re JONES (CCPA) 74 USPQ 149 (see footnote 2). The structural formula in claim 1 does not have a significant structural feature that is shared by all of its alternatives which is inventive. The structure has only a benzo fragment as common. This feature is not inventive. Compounds embraced by claim 1 are so diverse in nature that a prior art anticipating a claim with respect to one member under 35 USC 102 would not render obvious the same claim under 35 USC 103. This is evidentiary of patentably distinct and independent inventions.

Limiting the claims to the elected group would overcome this rejection.

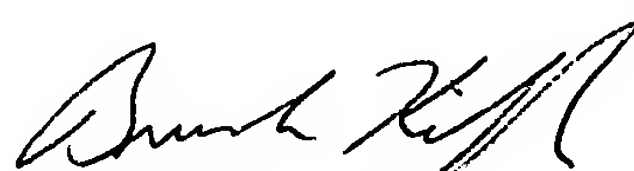
Applicants are advised to amend the claims to reflect the elected core and to also parallel the allowed claims in US 6,962,992

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruck Kifle, Ph.D. whose telephone number is 571-272-0668. The examiner can normally be reached Tuesdays to Fridays between 8:30 AM and 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. James Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Bruck Kifle, Ph.D.
Primary Examiner
Art Unit 1624

BK
January 3, 2006